

PATENT
Serial No. 10/053,451
Amendment in Reply to Office Action of August 30, 2005

REMARKS

Reconsideration of the present application and entry of the present amendment are respectfully requested.

In the Office Action, claim 1-30 are rejected under 35 U.S.C. §101 statutory double patenting, as allegedly claiming the same invention as that of claim 1 of copending Application No. 10/014,196. It is believed that only claim 1 is rejected under 35 U.S.C. §101 statutory double patenting, since claims 2-30 were rejected under the judicially created doctrine of obviousness-type double patenting. This rejection of claim 1 is respectfully traversed.

It is respectfully submitted that the claims are not directed to the same invention. Claim 1 in copending Application No. 10/014,196 is directed to a:

method of assembling and processing media
content from multiple sources, comprising: ...
automatically scanning available media
sources, selecting a source and extracting from
the media source, identifying information
characterizing the content of the source.
(Emphasis provided)

By contrast, claim 1 of the present application, as amended, is directed to a:

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method of providing alerts to sources of media content, comprising: ... automatically scanning available media sources, selecting a source and extracting from the content of the selected media source via analysis of rendered content, identifying information characterizing the content of the source. (Emphasis provided)

The MPEP under §804 II. A., in a section entitled "REQUIREMENTS OF A DOUBLE PATENTING REJECTION (INCLUDING PROVISIONAL REJECTIONS)", makes clear that (emphasis provided) "[i]n determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? 35 U.S.C. 101 prevents two patents from issuing on the same invention. 'Same invention' means identical subject matter." Miller v. Eagle Mfg. Co., 151 U.S. 186 (1984); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

Accordingly, to sustain a double patenting rejection under 35 U.S.C. §101, identical subject matter must be claimed. As guidance for determining whether identical subject matter is claimed, the MPEP section goes on to state that "[a] reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a

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corresponding claim in the patent. In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. For example, the invention defined by a claim reciting a compound having a 'halogen' substituent is not identical to or substantively the same as a claim reciting the same compound except having a 'chlorine' substituent in place of the halogen because 'halogen' is broader than 'chlorine.'"

It is respectfully submitted that a person of ordinary skill in the art would understand that "extracting from the media source," as recited in claim 1 of the copending Application No. 10/014,196, is broader than "extracting from the content of the selected media source via analysis of rendered content," as recited in claim 1 of the present application.

Accordingly, it is respectfully submitted that the rejection under 35 U.S.C. §101, for statutory double patenting is improper and an indication to that effect is respectfully requested.

The Examiner provisionally rejected claims 2-30 under the

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judicially created doctrine of obviousness-type double patenting as being unpatentable over a copending Application No. 10/014,196.

The Examiner indicated that a terminal disclaimer may be used to overcome this rejection. This rejection is also traversed for similar reasons noted above. However, it is respectfully submitted that Applicants will consider filing a terminal disclaimer, if necessary in view of any allowable claims, upon indication that the present application is otherwise allowable.

In the Office Action, claims 18-30 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Pub. No. 2002/0152463 (Dudkiewicz). Further, claims 1-6, 8 and 10-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pub. No. 2002/0147984 (Tomsen) in view of U.S. 6,449,767 (Krapf). Claims 7 and 9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tomsen in view of Krapf and U.S. Pub. No. 2003/0051252 (Miyaku). In addition, claims 15-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tomsen in view of Krapf and Dudkiewicz.

In response, independent claims 1 and 18 have been amended for better clarity to emphasis that the extracting is from the content

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that is rendered, e.g., from the content displayed on a TV.
Accordingly, no new issues requiring a new search is introduced and thus entry of the present amendment is respectfully requested.
Claims 1 and 18 were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. It is respectfully submitted that claims 1-5 and 7-30 are patentable over Dudkiewicz, Tomsen, Krapf and Miyaoku for at least the following reasons.

Dudkiewicz is directed to a system and method for personalized presentation of video programming. As recited throughout Dudkiewicz, the Dudkiewicz device "determines a preferred programming event from among available programming events using programming event metadata and one or more viewer profiles." (See abstract)

In stark contrast, the present invention as recited in independent claim 1, and similarly recited in independent claim 18 requires:

extracting from the content of the selected media source via analysis of rendered content.
(Emphasis added)

This feature of extracting from the content, via analysis of

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the rendered content, such as the content displayed on a TV, (as opposed to extracting information merely from metadata) is nowhere taught or suggested in Dudkiewicz, Tomsen, Krapf, Miyaoku, and combinations thereof.

Accordingly, it is respectfully submitted that independent claims 1 and 18 are allowable, and allowance thereof is respectfully requested. In addition, it is respectfully submitted that claims 2-5, 7-17 and 19-30 should also be allowed at least based on their dependence from independent claims 1 and 18.


In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

In view of the above, it is respectfully submitted that the present application is in condition for allowance, and a Notice of Allowance is earnestly solicited.

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It is believed that no additional fees or charges are currently due. However, in the event that any additional fees or charges are required for entrance of the accompanying amendment, they may be charged to applicant's representatives Deposit Account No. 50-3649. In addition, please credit any overpayments related to any fees paid in connection with the accompanying amendment to Deposit Account No. 50-3649.

Respectfully submitted,

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